UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/978,224
Filing Date: October 16, 2001
Appellant(s): BAHAR, REUBEN

_____
Marvin A. Glazer
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/6/2009 appealing from the Office action

mailed 2/3/2009.

(1)   Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2)   Related Appeals and Interferences

A statement identifying the related appeals and interferences, which will directly

affect or be directly affected by or have a bearing on the decision in the pending appeal,

is contained in the brief.

(3)   Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4)   Status of Amendments

The statement of the status of the Amendment contained in the brief is correct.

(5)   Summary of claimed subject matter

The summary of the claimed subject matter is contained in the brief is correct.

(6)   Grounds of Rejection to be reviewed on appeal

The following ground(s) of rejection are applicable to the appealed claims:

Claims 184-189, 191-213, 215-229, 231-234, 236-243, 248-255, 258-271, 279,

327-340 and 346-348 are rejected under 35 U.S.C. 103(a). This rejection is set

forth in a prior office action, mailed on February 3, 2009.

(7)   Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8)   *Evidence Relied Upon*

6,629,131 B1	Choi et al.	09-2003
6,618,747 B1	Flynn et al	09-2003
6,836,846 B1	Kavensky et al	12-2004

(9)   *Grounds of Rejection*

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Amended claim 248 is rejected under 35 U.S.C 101 because the software is not embodied on "computer storage medium" making the claim non-statutory. Appropriate correction is required.

3.   Dependent claims 249-251 & 346 are also rejected under 35 U.S.C 101 by virtue of their dependent on claim 248.

4.   Amended claim 252 is also rejected under 35 U.S.C 101 because the software is not embodied on "computer storage medium" making the claim non-statutory. Appropriate correction is required.

5.   Dependent claims 253-255, 279, 347 & 348 are also rejected under 35 U.S.C 101 by virtue of their dependent on claim 252.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7.   Claim 236 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Line 3 of claim 236 states "receiving an e-mail <u>into</u> a recipient e-mail address". The claim language is indefinite and un-clear as to how an email can be received <u>into</u> an e-mail address. For examine purposes examiner has assumed the above claim language as "receiving an e-mail <u>at</u> a recipient e-mail address". Appropriate correction is required to clarify the indented meaning.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 184-189, 191-213, 215-229, 231-234, 236-243, 248-255, 258-271, 279, 327-340, 346-348 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi (U.S. 6,629,131B1), Flynn et al (U.S. 6,618,747B1) and Kanevsky et al (U.S. 6,836,846).

10.　　As per claims 236, 248, 260, 252, 258, 264, 268 Choi disclosed a method for

verifying whether an e-mail received by a recipient was accessed by an intended

recipient, said method comprising: a) receiving an e-mail at a recipient e-mail address

(col.2, lines 59-67). However Choi did not explicitly disclose b) detecting an access

event, and prompting the party associated with said event to input recipient data prior to

allowing the requested access (c) biometric identification means for recognizing

biometric attributes of an individual (d) acquiring recipient data that is related to

biometric identification of the recipient (e) permitting said e-mail to be accessed after the

party associated with the said access event inputs said recipient data (f) means for

sending identifying data relating to the party associated with said access event for

reference by a sending party to identify the party who accessed the e-mail.

In the same field of endeavor Kanevsky et al disclosed b) detecting an access event,

and prompting the party associated with said event to input recipient data prior to

allowing the requested access (col.6, lines 1-26) (c) biometric identification means for

recognizing biometric attributes of an individual (d) acquiring recipient data that is

related to biometric identification of the recipient (col.4, lines 62-67, col.5, lines 1-15 &

col.5, lines 46-67) (e) permitting said e-mail to be accessed after the party associated

with the said access event inputs said recipient data (col.7, lines 7-10).

It would have been obvious to one in the ordinary skill in the art at the time the invention

was made to have incorporated detecting an accessing individual through utilization of

biometric attributes as disclosed by Kanevsky in a method of verifying whether e-mail was delivered to the intended recipient as disclosed by Choi in order to enhance the security of the e-mail delivery system resulting in secure and protected reception of the e-mail by only the intended actual recipient.

Both Choi and Kavensky did not explicitly disclose, (f) sending identifying data relating to the party associated with said access event for reference by a sending party to identify the party who accessed the e-mail.

In the same field of endeavor Flynn disclosed (f) sending identifying data relating to the party associated with said access event for reference by a sending party to identify the party who accessed the e-mail. (col.6, lines 53-56).

It would have been obvious to one in the ordinary skill in the art at the time the invention was made to have incorporated sending identifying data relating to the party associated with said access event for reference by a sending party to identify the party who accessed the e-mail as disclosed by Flynn in a method of verifying whether e-mail was delivered to the intended recipient as disclosed by Choi and Kanevsky in order to make the e-mail delivery system more secure and protected by giving the sender the ability to know exactly whether the e-mail content was delivered to the recipient resulting in assured and verified communication between users on a network.

11.   As per claims 185,191, 208-210, 215, 249-251, 253-255, 259, 261-263, 265-267,
269-271, 279, 327, 329, 335, 336, 338 & 346-348 Choi-Flynn-Kanevsky disclosed the
method as recited in claim 258 wherein said step of recipient data for confirming proper
delivery of said e-mail includes the steps of: (a) generating a confirmation of receipt
notice wherein the inputted recipient data is included with said confirmation receipt
notice; and (b) sending said confirmation of receipt notice, wherein the inputted receipt
data included with said confirmation of of receipt can be compared to information
associated with said intended recipient in order to verify whether the e-mail was
accessed by the intended recipient (Flynn, col.6, lines 66-67 & col.7, lines 1-21).

12.   As per claims 212 Choi-Flynn-Kanevsky disclosed the method as in claim 260,
wherein the step of transmitting an e-mail from a sender computer includes attaching an
executable attachment file in conjunction with the e-mail, the executable attachment file
having a first module for discovering the stored recipient data file that is associated with
actual recipient e-mail address and wherein the step of detecting an access event
includes the step of executing the first module of the executable attachment file (Flynn
col.53-67 & col.7. lines 1-19).

13.   As per claims 213 Choi-Flynn-Kanevsky disclosed the method as in claim 212,

wherein the executable attachment file has a fourth module transmitted and delivered

therewith, the fourth module for detecting the access event, and further comprising the

step of automatically executing the fourth module upon delivery of the attachment file to

the recipient e-mail address (Flynn col.53-67 & col.7. lines 1-19).

14.   As per claims 216 Choi-Flynn-Kanevsky disclosed the method as in claim 215,

wherein said recipient computer is a server of a service provider that is capable of

receiving e-mail (Choi, col.2, lines 59-67).

15.   As per claim 233 Choi-Flynn-Kanevsky disclosed the method as in claim 260,

wherein said recipient data is acquired as a requisite condition for operating a remote

user computer, said remote user computer being operable to gain access to said

recipient e-mail address (Flynn, col.5, lines 46-67 & col.6, lines 1-21).

16.   As per claims 218, 198, 196, 200, 234, 238, 239, 240, 241, 195, 219, 222, 243,

199, 221, 242, 197, 203, 225, 204, 226, 205, 227, 201, 223, 193, 217, 187, 211, 330,

331, 334, 337, 339 & 340 Choi-Flynn-Kanevsky disclosed the method as in claim 155,

wherein said acquired recipient data is related to alphanumeric text identification,

biometric identification, password identification, a computer generated user code, or a

combination thereof (Bisbee, col.1, lines 37-51 & col.4, lines 36-67).

17.   As per claims 202 & 224 Choi-Flynn-Kanevsky disclosed the method as in claim

236 further including the step of sending access event data of attendant conditions of

said access event (Flynn col.6, lines 53-67 & col.7. lines 1-19).

18.   As per claims 206, 207, 228 & 229 Choi-Flynn-Kanevsky disclosed the method

as in claim 236, wherein said step of identifying data is used to verify proper delivery of

legal documents, confidential documents (Flynn, col.5, lines 46-67 & col.6, lines 1-21).

19.   As per claim 332 Choi-Kanvesky-Flynn disclosed the method as in claim 258

wherein said recipient data for confirming proper delivery of said e-mail is sent to an e-

mail address(Choi, col.2, lines 60-67 & col.3, lines 1-9).

20.   As per claim 334 Choi-Kanvesky-Flynn disclosed the method as in claim 258,

wherein said inputted recipient data pertains to alphanumeric text identification,

biometric identification, password identification, a computer generated user code, or a

combination thereof (Kanevsky, col.4, lines 62-67, col.5, lines 1-15 & col.5, lines 46-67).

21.   As per claim 184 Choi-Kanvesky-Flynn disclosed the method as recited in claim

258 wherein said step of sending recipient data for confirming proper delivery of said E-

mail includes the steps of: a) generating a confirmation of receipt notice wherein the

inputted recipient data is included with said confirmation of receipt notice; and b)

sending said confirmation of receipt notice, wherein the inputted recipient data included

with said confirmation of receipt notice can be compared to information associated with

said intended recipient in order to verify whether the e-mail was accessed by the

intended recipient (Choi, col.2, lines 60-67 & col.3, lines 1-9).

As per claim 333 Choi-Kanvesky-Flynn disclosed the method as in claims 184, wherein

said confirmation of receipt notice is sent to an e-mail address (Choi, col.2, lines 60-67

& col.3, lines 1-30).

(10) Response to Arguments

Examiner notes that under the arguments section A: from pages 8 through 11

applicants explained the three prior arts.

Under section C with respect to claims 184-189, 191-213, 215-229, 231-234, 236-243,

248-255, 258-271, 279, 327-340, 346-348 appellant argued on the following limitations

against the applied prior art Choi (U.S. 6,629,131B1), Flynn et al (U.S. 6,618,747B1)

and Kanevsky et al (U.S. 6,836,846).

Issue 1: Appellant on the last paragraph of page 12 with respect to claim 236 argued

that "While the Examiner states, in the final Office Action (see page 5) that Kanevsky

did not explicitly disclose the limitation "sending identifying data related to the party

requesting access for reference by the sender", but Kanevsky's remote authorization

method performs such functionalty.

As to appellants argument examiner points out that appellant has not argued the above

limitation in its entirety which was addressed on page 5 of the final office action dated

2/3/2009 which states **"(f) sending identifying data relating to the party associated**

with said access event for reference by a sending party to identify the party who

accessed the e-mail". As to appellants argument "authorization" in Kavensky merely

allows the access to the e-mail as explained in the rejection. This limitation is dealing

with the "notification" aspect of the invention in which a notification is sent to the sender

identifying **the party who accessed the e-mail**. Since Kanevsky is clearly lacking the

"notification" functionality therefore for this reason Flynn was introduced in the rejection

which discloses the "notification" functionality with respect to the limitation in question.

Hence appellant's allegation is improper.

Issue 2: Appellant on line 15 through 26 of page 14 with respect to claim 236 argued that As noted above, Kanevsky's method requires verification that the identity of the party requesting access to the email matches the identity of the intended recipient before allowing access to the e-mail. If the identity of the requesting party does not match the sender's intended recipient, then access to the e-mail is altogether denied by Kanevsky; only if the party seeking access submits identification specified by the sender will Kanevsky permit access to the e-mail. On the other hand, Kanevsky cannot identify persons requesting access who are not the recipient intended by the sender, nor will Kanevsky permit access to such e-mail in such instances and goes on to argue that the combination of Choi and Kanevsky fails to achieve the method cited in claim 236.

Examiner has already explained the distinct reasons for applying Flynn and Kanevsky on the limitation **"(f) sending identifying data relating to the party associated with said access event for reference by a sending party <u>to identify the party who accessed the e-mail</u>"** of claim 236 in issue 1. As to appellant's argument regarding improper combination of Choi and Kanevsky to reject claims 236, examiner points out that the rejection for claim 236 is based on <u>**three**</u> prior arts **Choi, Kanevsky and Flynn** rejected under 35 U.S.C. 103(a) therefore appellant's argument based on only two prior arts is improper.

Issue 3: One page 16 appellant says that his previous arguments for claim 236 are also applicable to the rejections of claim 248, 252, 258, 260, 264 and 268 without any further argument.

As to appellants statement examiner notes that since the arguments for claim 236 are already addressed therefore claims 248, 252, 258, 260, 264 & 268 are also addressed and anticipated by the applied prior arts for the same reasons.

Issue 3: On the last paragraph of page 17 appellant argues that Kanevsky actually teaches away from the claimed invention because it would lead one skilled in the art away from the path chosen, and claimed, by Appellant. Claims 236, 248, 252, 258, 260, 264 and 268 all recite that access to the e-mail message is permitted once the party requesting access party inputs recipient data (see claims 236, 248, 258, 260), biometric attributes of said individual (see claim 252), or biometric identification (see claims 264 and 268). In contrast, Kanevsky teaches that access is permitted when the party requesting access matches the intended recipient. A cited reference "teaches away" from the claimed invention when a person of ordinary skill, upon reading the reference,

would be ... led in a direction divergent from the path that was taken by the applicant. In

re Kubin, 561 F3d 1351, 90 USPQ2d 1417, 1421 (Fed. Cir. 2009), citing In re Gurley, 27

F.3d 551,553 [31 USPQ2d 1130] (Fed. Cir. 1994). Where the prior art teaches away

from the claimed invention, the claimed invention is more likely to be non-obvious.

As to appellant's argument examiner again points out that the rejection for claims 236,

248, 252, 258, 260, 264 & 268 is based on **three** prior arts **Choi, Kanevsky and Flynn**

rejected under 35 U.S.C. 103(a). Since appellant's argument completely ignored Flynn,

therefore appellant's argument is improper. Additionally, **examiner points out that the**

claims do not require that anyone other than recipient be able to access the e-

mail.

With respect to appellants' argument regarding non-obliviousness to combine Choi and

Kanevsky examiner notes that by merely reading the abstract of the two references one

in the ordinary skill in the art can recognize that both of these prior arts are dealing with

e-mail functionality. Choi (Titled: "Registration mail system with a sent mail check

function on internet and method for the same") discloses verifying whether an-email was

accessed by a recipient however Choi did not explicitly disclose detecting an access

event and prompting the party associated with the event to input recipient data (Bio

metric data).....In he same filed of endeavor Kanevsky (Titled: Method and apparatus

for controlling E-mail Access) disclosed disclose detecting an access event and

prompting the party associated with the event to input recipient data (Bio metric data) in

order to access the e-mail. Therefore it would be obvious to one in the ordinary skill in

the art to have an added security measure of inputting bio-metric information as

disclosed by Kanevsky to access an e-mail sent by Choi. All the pertinent sections are

cited in the rejection.

Additionally, in response to applicant's arguments against the references individually,

one cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. In the present case **Choi,**

Kanevsky and Flynn. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In*

re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Issue 4: Finally on page.18 appellant alleged that corresponding dependent claims 184-

189, 191-213, 215-229, 231-234, 236-243, 248-255, 258-271, 279, 327-340, and 346-

348 are also rejected for the same reasons given for independent claims 236, 248, 252,

258, 260, 264 & 268.

As to appellants' argument dependent claims 189, 191-213, 215-229, 231-234, 236-

243, 248-255, 258-271, 279, 327-340, and 346-348 are rejected for the same reasons

given for their corresponding independent claims 236, 248, 252, 258, 260, 264 & 268.

(11)   Related proceedings appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

/Asghar Bilgrami/
Examiner, Art Unit 2443
October 2, 2009

Conferees
/Larry D Donaghue/
Primary Examiner, Art Unit 2454

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